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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/390,363	09/07/1999	JON N. LEONARD	BEU/LEONARD	6725

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EXAMINER

LEE, CHI CHUNG

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 09/05/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/390,363	Applicant(s) LEONARD ET AL.	
	Examiner Chi-Chung E Lee	Art Unit 2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 1999.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4,5,6</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 34 recites the limitation "said processing limitations" in line 15. There is insufficient antecedent basis for this limitation in the claim. The examiner will interpret the word "**said**" with the character 'a' to this claim

Claims 35-37 are rejected as dependent claims of claim 34.

Claim Rejections - 35 USC § 102

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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1. Claims 1-16, 18-32, 34-50 are rejected under 35 U.S.C. 102(e) as being anticipated by Anderson (US 6,442,600 B1).

As per claim 1, Anderson discloses an electronic mail system (i.e. system for distributing electronic messages, see figure 1) comprising:

- a) a first computer 150 (i.e. the sender, see column 3 lines 61-63) which is connect to a network 140 capable of carrying an electronic mail message (i.e. transmission of the electronic messages, see column 4 line 65- column 5 line 1);
- b) recipient computers systems (elements 160, 170, and 180; see figure 1) are connected to network 140 [see column 4 lines 59-65];
- c) a view applet (i.e. the message receiver 155 with the URL, the web browser software, see column 4 lines 13-16);

Anderson discloses the electronic message (i.e. e-mail) includes minimum or maximum expiration time periods (i.e. time is attached to the electronic mail message prior to transmission over network, see column 3 lines 62-67) will cause the electronic message and all designated incarnations thereof to expire. Anderson also discloses the electronic message (i.e. E-mail) is encrypted so that it may only be viewed using said view applet (i.e. URL web browser) upon installation of upon installation of said view applet on the recipient computers (i.e. element 160, 170, 180; see figure 1 and column 5 lines 25-30).

As per claims 2, 3, 8-9, Anderson discloses the electronic mail system (i.e. system for distributing electronic messages, see figure 1) further comprising a central electronic mail server

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(i.e. Message Distribution server (MDS), see figure 1) connected to the network 140. Anderson discloses the message sender to supply the electronic message to the MDS and the MDS will stores the message and is responsible for forwarding it to the recipient [see column 5 lines 19-50]. Anderson also discloses the MDS will retrieve the public key from the recipient and encrypt the electronic message upon request by the recipient and stream it to corresponding recipient [see figure 6 steps 625,630,635,640]. The recipient can access the message by decrypting it using the private key of the recipient computer system's private key and display said electronic message [see column 6 lines 16-29].

As per claims 4-5, Anderson discloses the recipient (i.e. a user) can select a message and indicate a message forwarding action to be taken (i.e. forward to a second recipient computer, see figure 2 and column 6 lines 46-65). Anderson discloses the message distributor subroutine of MDS (i.e. central mail server) being arrange to encrypt the message using the public encryption key generated in the recipient computer system [see column 5 lines 58-63] and send it to each recipient [column 9 lines 9-16].

As per claim 6, Anderson discloses the central electronic mail server (i.e. MDS) erases (i.e. deletes) the single copy of the electronic message when the end of a maximum time period has expired [see column 4 lines 25-44].

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As per claim 7, Anderson discloses the central electronic mail server (i.e. MDS) erases (i.e. deletes) the single copy of the electronic message when the end of a maximum time period has expired [see column 4 lines 25-44].

As per claims 10-12, Anderson discloses the electronic message (i.e. E-mail) is encrypted in the central mail server (i.e. Message Distribution Server) with the recipient's public key before transmission to said recipient computer [see column 10 lines 5-14 and figure 6 steps 625,630,635,640].

As per claims 13, Anderson discloses Message Receiver (MR) stores the decrypted message indicator (i.e. e-mail) in an encrypted fashion on the recipient computer system [see column 6 lines 16-29] and erase (i.e. delete) the message if the expiration period has ended (i.e. upon the occurrence of said date, time, or event, see column 9 lines 64-66).

As per claims 14-15, Anderson discloses the recipient (i.e. a user) can select a message and indicate a message forwarding action to be taken (i.e. forward to a second recipient computer, see figure 2 and column 6 lines 46-65). Anderson discloses the message distributor subroutine of MDS (i.e. central mail server) being arranged to encrypt the message using the public encryption key generated in the recipient computer system [see column 5 lines 58-63] and send it to each recipient [column 9 lines 9-16].

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As per claim 16, Anderson discloses the message origination software (i.e. message sender 154, see figure 1) arranged to permit the message to include the expiration time (i.e. limitation, see column 3 lines 62-65) before transmission over said network 140 [see column 3 lines 48-66 and figure 2).

As per claims 18-32, the claimed steps correspond to the functions of the elements of the apparatus claims 1-16, which has been rejected above, and thus rejected with the same reason applied thereto.

As per claim 34, Anderson discloses an electronic mail system (i.e. system for distributing electronic messages, see figure 1) comprising:

- a) a first computer 150 (i.e. the sender, see column 3 lines 61-63) on which is installed message origination software (i.e. message sender software 154, see figure 1) and which is connect to a network 140 capable of carrying an electronic mail message (i.e. transmission of the electronic messages, see column 4 line 65- column 5 line 1);
- b) recipient computers systems (elements 160, 170, and 180; see figure 1) are connected to network 140 [see column 4 lines 59-65];
- c) a view applet (i.e. . the message receiver 155 with the URL, the web browser software, see column 4 lines 13-16);
- d) a central electronic mail server (i.e. Message Distribution server (MDS), see figure 1) connected to the network 140. Anderson discloses the message sender to supply the electronic message to the MDS and the MDS will stores the message and is responsible for forwarding it to

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the recipient [see column 5 lines 19-50]. Anderson also discloses the MDS will retrieve the public key from the recipient and encrypt the electronic message upon request by the recipient and stream it to corresponding recipient [see figure 6 steps 625,630,635,640]. The recipient can access the message by decrypting it using the private key of the recipient computer system's private key and display said electronic message [see column 6 lines 16-29].

Anderson also discloses the processing limitations (i.e. restriction on access by some or all recipients, see column 3 line 65-column 4 line 1) are implemented by said central electronic mail server (i.e. MDS) and message receiver 155 (i.e. said view applet, see figure 1).

As per claim 35, Anderson discloses the message is encrypted by MDS using a public key generated by the message receiver 155 (i.e. said view applet, see figure 1) and decrypted with corresponding private key in the recipient computer system [see figure 6 steps 625-640 and figure 7 step 715].

As per claims 36-37, Anderson discloses the recipient (i.e. a user) can select a message and indicate a message forwarding action to be taken (i.e. forward to a second recipient computer, see figure 2 and column 6 lines 46-65). Anderson discloses the message distributor subroutine of MDS (i.e. central mail server) being arranged to encrypt the message using the public encryption key generated in the recipient computer system [see column 5 lines 58-63] and send it to each recipient [column 9 lines 9-16].

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As per claims 38-40, the claimed steps correspond to the functions of the elements of the apparatus claims 34-37, which has been rejected above, and thus rejected with the same reason applied thereto.

As per claim 41, Anderson discloses a computer program for handling electronic mail comprising:

a) a mail original portion (i.e. message sender 154, see figure 1) arranged to permit the sender to supply messaging sending information including optional information as minimum and maximum expiration time (i.e. a date, time or event, see column 3 lines 62-65). The Message Receiver (MR) stores the decrypted message indicator (i.e. e-mail) in an encrypted fashion on the recipient computer system [see column 6 lines 16-29] and erase (i.e. delete) the message if the expiration period has ended (i.e. upon the occurrence of said date, time, or event, see column 9 lines 64-66).

b) a view applet portion (i.e. message receiver 155, see figure 1) arranged to access the message by decrypting it using the private key of the recipient computer system's private key and display said electronic message [see column 6 lines 16-29] and permit viewing of the received electronic message before the expiration time period end [see column 9 lines 66-67].

As per claim 42, Anderson discloses a computer program of the MDS will retrieve the public key from the recipient and encrypt the electronic message upon request by the recipient and stream it to corresponding recipient [see figure 6 steps 625,630,635,640]. The recipient can access the

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message by decrypting it using the private key of the recipient computer system's private key and display said electronic message [see column 6 lines 16-29].

As per claim 43, Anderson discloses the compute program to erase (i.e. delete) the message if the expiration period has ended (i.e. upon the occurrence of said date, time, or event, see column 9 lines 64-66).

As per claims 44-45, Anderson discloses the mail original portion (i.e. message sender 154, see figure 1) arranged to permit the sender to attach a copy of said view applet portion (i.e. message receiver 155, see figure 1) to each message including optional information as minimum and maximum expiration time (i.e. a specified expiration date, time or event, see column 3 lines 62-65). Anderson also discloses the message tracking table is arranged to implement handling and processing controls on a received message [see figure 2].

As per claims 46-50, the claimed steps correspond to the functions of the elements of the apparatus claims 41-45, which has been rejected above, and thus rejected with the same reason applied thereto.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 17, 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson as applied to claims 1, 16, 18, 32, above.

As per claim 17, Anderson does not expressly disclose the processing and handling limitations are implemented by said view applet (i.e. the message receiver 155). It would have been obvious to a person of ordinary skill in the art at the time of invention was made to implement the request from the message receiver 155 (i.e. view applet) of the message recipient to review, save, or delete an indicated message (i.e. processing and handling limitations) with in the system of Anderson because it's well known in the art to activate the subroutine software such as view applet in the recipient computer system to handling the access limitation of the electronic message.

As per claim 33, the claimed steps correspond to the functions of the elements of the apparatus claims 17, which has been rejected above, and thus rejected with the same reason applied thereto.

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Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chi-Chung E Lee whose telephone number is 703-306-4153.

The examiner can normally be reached on 8 am - 5 pm, Mon. - Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

C. L.
Chi-Chung Lee
August 28, 2003


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